REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and the personal interview conducted on August 3, 2005, and amended as necessary to more clearly and particularly describe and claim the subject matter that Applicants regard as the invention.

Claims 1–10, 12 and 14 remain in this application. Claims 11, 13 and 15–20 have been canceled. New claims 21–25 have been added without adding any new matter.

Claims 1–10 and 12–14 were rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the written description requirement. This rejection is traversed for the following reasons.

In the Office Action the Examiner argues that the use of "another apparatus" is not supported by the specification. Applicants respectfully disagree. As discussed at the personal interview, Figure 1 of the application shows a "Moving Picture Data Producing Apparatus 101," whereas Figure 2 shows a "Moving Picture Coding Apparatus 201." Note that the apparatus 101 has both input means 116 and output means 115, and the different apparatus 201 has input means 202 and output means 206. Furthermore, the discussion accompanying these figures makes clear that the output of apparatus 101 can be input into the apparatus 201 (see paragraph [0091], for example). Thus, the written description clearly and unambiguously supports the use of two separate apparatuses.

For example, claim 1 is directed toward an "a moving picture data producing apparatus for generating outputted moving picture data" (e.g., apparatus 101) having "output means for outputting said compression frame data to a moving picture coding

apparatus" (e.g., apparatus 201) "wherein said moving picture coding apparatus is used to change the bit rate of said compressed moving picture data by utilizing said rate correction data and a desired bit rate input to said moving picture coding apparatus." Similarly, the other independent claims all recite these separate apparatuses.

Furthermore, as discussed in detail at the personal interview, paragraphs [0069] to [0087] discuss the moving picture data producing apparatus that outputs compression frame date. Paragraphs [0089] to [0091] discuses this compression frame data being input to the moving picture coding apparatus.

The Examiner also argues in the Office Action that the phrase "compressed moving picture data input to said apparatus so as to comply with a bit rate to be output" is not supported by the specification. Again, as discussed at the personal interview, Applicants respectfully disagree. Although amendments to the claims make this rejection moot, it is clear from the specification that apparatus 201, for example, is utilized for changing the bit rate of the inputted moving picture data according to a desired bit rate for output. In particular, see paragraphs [0091] to [0095], where this operation is discussed in detail (in particular, see paragraph [0091], where is it made clear that this apparatus 201 inputs compressed moving picture data). Furthermore, a reading of the specification, as a whole, makes clear that a feature of one of the apparatuses of the invention is to change the bit rate of moving picture input data to a desired bit rate, without fully decompressing the input data. Thus, the specification clearly supports the prior and the current claim language.

For at least the above reasons, the rejection is improper and should be withdrawn. Applicants note that claims 7 and 14 have not been rejected under any prior art, and thus should be in a condition for allowance.

Furthermore, the Examiner requested, at the personal interview, that Applicant's representative point out to the Examiner the teachings in the specification that support the claims and the claim amendments. First, it is noted that Figure 6 shows a moving picture coding apparatus with the input and output means, moving picture coding means, rate correction data producing means, and compression frame means recited in the independent claims. Figure 7 shows the moving picture coding apparatus with the input means and output means, and the rate correction data extraction means and rate correction means of the claims. Furthermore, Figures 1–5, 8, 9, 21, 29, 35, 37 and 38, along with the corresponding description in the specification, describe these apparatuses in more detail, in particular, providing examples as to how the moving picture coding means and the rate correction means may be implemented.

Finally, the claim language has been amended to use the same terminology in the claims as is used in the figures, as requested by the Examiner at the personal interview, and more structure has been added to the claims, as also suggested. Accordingly, the amended claims fully comply with the written description requirement.

Claims 1, 2, 9, 10, 12, 13, 15 and 20 were rejected as being anticipated by Yanagihara *et al.* (U.S. 5,745,644). Claims 3, 4/1, 4/2, 4/3, 5 and 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yanagihara in view of Sethuraman *et al.* (U.S. 6,037,987). Claims 6 and 16–19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yanagihara in view of Shimizu *et al.* (U.S. 5,748,245). For the following reasons, the rejections are respectfully traversed.

Claim 1 recites a " moving picture data producing apparatus" for producing "rate correction data" to be added to "compressed moving picture data" to produce

"compression frame data" and further having output means for "outputting said compression frame data to a moving picture coding apparatus, wherein said moving picture coding apparatus is used to change the bit rate of said compressed moving picture data by utilizing said rate correction data and a desired bit rate input to said moving picture coding apparatus." Claim 9 recites similar limitations, as do new claims 21 and 24.

Similarly, claim 12 recites a "moving picture coding apparatus" having "input means for inputting compression frame data output from a data producing apparatus" and for using the rate correction data in the compression frame data for "generating modified compressed moving picture data by changing the bit rate of said compressed moving picture data to the desired bit rate utilizing said information about the compressed moving picture data." Claims 21 and 24 recite similar limitations.

As discussed at the personal interview, the cited references do not teach these limitations of the claims.

In the Office Action, the Examiner cites Yanagihara as teaching a moving picture coding apparatus according to the claims. However, as discussed in the prior two responses and at the personal interview, Yanagihara does not teach the production of any "rate correction data" which is used by ***another*** apparatus to change the bit rate of already compressed moving picture data. Nowhere does Yanagihara even discuss ***another*** apparatus changing a *bit rate*.

In response to this twice previously supplied argument, the Examiner responded that circuit 14 of Yanagihara is considered the "another apparatus." For the reasons listed below, Applicant disputes that Yanagihara provides any teaching that circuit 14 is an "another apparatus" and that any such interpretation is unreasonable.

First, circuit 14 is found in Fig. 1, which is described in the reference as being "a block diagram of the recording system of a digital VTR..." (col. 3, lines 26–27). Thus, each block in the diagram of FIG. 1 is merely a component of the digital VTR. There is nothing that suggests otherwise in either the figure or the figure description.

Furthermore, Figure 1 is described as illustrating "the recording system of a digital VTR in accordance with an advantageous embodiment..." Again, this clearly implies that Figure 1 merely shows a collection of the components making up the digital VTR apparatus.

Finally, the specification discusses circuit 14 in col. 8, lines 16–42. There is no teaching that circuit 14 represents an "another apparatus" as suggested by the Examiner. Instead, one skilled in the art would clearly understand that the cited section is merely describing the component parts of the apparatus for encoding a digital video signal.

As Applicant has made clear above when discussing the written description rejection, the invention discloses at least one first apparatus 101 and at least another apparatus 201. See also apparatuses 601 and 701 of Figures 6 and 7, respectively. As discussed at the personal interview, these are separate apparatuses, as one skilled in the art would understand the term "apparatus" to mean. In his response to Applicants arguments, the Examiner argues in the Office Action that element 111 of Figure 1 of the application is the "another apparatus." This is clearly improper, as Figure 1 makes clear that all of the elements within box 101 are part of the apparatus 101. A component of apparatus 1 cannot be apparatus 2. Claim 1 clearly recites that the apparatus generates *outputted* moving picture data for use by a different apparatus. Instead, the Examiner, in the Office Action, is clearly confusing the meanings of apparatus and a component (or element) of that apparatus.

Consequently, the Examiner's assertion is improper, because the reference does not teach that circuit 14 is an "another apparatus," and no such another apparatus is identified, and thus the independent claims are patentable over the Yanagihara reference for the above reasons.

Furthermore, claim 1 also recites "compression frame data means for adding said rate correction data to said compressed moving picture data to generate compression frame data" and "output means for outputting said compression frame data." Claims 9, 21 and 24 recite similar limitations. There is nothing in Figure 1 of the Yanagihara reference, nor in the specification, that shows rate correction data being added to compressed moving picture data for output by the device. In fact, Figure 1 of the reference clearly teaches that the input to circuit 14 (which the Examiner likens to the rate correction data) is input to circuit 14, whereas the compressed moving picture data is added to the compressed moving picture data, which is output by the recording heads 18A, 18B. Thus, the reference clearly teaches that the output of circuit 12 is used by circuit 14 to influence the operation of circuits 8 and 9 (see col. 8, lines 16–42). But there is nothing to suggest that the output of circuit 12 is added to anything at all. Accordingly, claims 1, 9, 21 and 24 are patentable for this reason as well.

Furthermore, claim 12 recites "rate correction data extraction means for extracting said information about the compressed moving picture data from said rate correction data of said compression frame data." Similar limitations are found in claim 24. There is nothing in the cited reference that teaches such a data extraction means, and thus claims 12 and 24 are patentable over the Yanagihara reference for this reason as well.

Still further, claims 12 and 24 recite that "the bit rate is changed without decoding all of said inputted compressed moving picture data."

The Examiner cites circuit 14 and col. 7, line 55 to col. 8, line 43 as teaching changing the bit rate without decoding the inputted moving picture data. However, there is no suggestion found in the reference that the inputted data to Yanagihara is compressed. In fact, the input to the Yanagihara device (at terminals 1A, 1B, and 1C) is taught to be a digital luminance signal, not a compressed signal. Hence, claim 12 is patentable over the reference.

In response to this previously supplied argument as provided in the Office Action, the Examiner appears to be arguing that item 14 in Figure 1 of the reference is the "apparatus" that is inputting the compressed moving picture data. But the "compressed" data that the Examiner refers to can only be internal to the apparatus of Figure 1, not input to it. As discussed above, the Examiner is confusing an apparatus with the components of an apparatus. Yanagihara makes clear that Figure 1, in its entirety, is the apparatus. The various blocks of that figure are merely components of the apparatus. Thus, because the output of item 9 (and likewise items 2–7A, B) is all internal to the apparatus, the reference cannot teach the cited claim limitation. The inputs of the Yanagihara device are found at 1A, 1B, and 1C, which are not taught by the reference as being compressed.

Accordingly, it is improper for the Examiner to argue that Yanagihara teaches inputting compressed video data, as it clearly does not.

Furthermore, the section cited by the Examiner as teaching changing the bit rate of compressed data without decoding does not support such an interpretation. The Examiner cites col. 7, line 55 to col. 8, line 43 as providing such a teaching. But a close reading of that section only shows that the Yanagihara device is merely going through an interactive process in order to obtain data compressed less than a predetermined amount (see col. 8, lines 23–26). In fact, there is no discussion of changing a bit rate of compressed data at

all. Instead, it is clear from reading that passage that the reference is teaching a means of compressing an uncompressed signal to be less than a predetermined amount.

Still further, the predetermined amount as defined in the cited section is not a "bit rate" at all, but is merely an "amount of the quantized and variable length coded data within the 15 macro blocks stored in the buffer memory." This is not a "rate" at all, but an amount of data that is statically stored in the memory. The entire cited section is totally silent as to any bit rate change. None of the additionally cited references overcome the shortcomings discussed above.

Thus, claims 1, 9, 12, 21 and 24 are patentable over Yanagihara for any of the reasons cited above. None of the other references overcome the shortcomings of Yanagihara, and thus the claims are also patentable over the combination of references as well.

The remaining claims depend on one of the claims cited above, and thus are patentable over the references for at least the same reasons as the parent claims.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*). The fact that the claimed invention is within the *capabilities* of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (*Id.*).

The Examiner is reminded that the burden does not shift to the Applicants to dispute a finding of obviousness until the Examiner has made a proper prima facie case of obviousness. The Examiner has not done so. Instead, the Examiner improperly applies hindsight reasoning to provide the motivation.

The Examiner argues that it would have been obvious to one having both cited references in front of him/her, and the general knowledge of MPEG video compressions, to provide the invention. This statement of motivation is faulty for the following reasons. First, the Examiner does not state what motivates the inventor to have the specific references in front of him/her. Although one skilled in the art is charged with knowing that which is known in the art, the teachings of the art are many. Thus, what would motivate an individual to combine those specific references together? What would motivate the inventor to take these two, of all the thousands of references in this field, and put them side-by-side? Surely, only knowledge of the application itself would provide any such motivation, for the Examiner has not shown any motivation found in the references themselves. Only one who knows what to look for would find those two particular references and put them together. Thus, this is improper hindsight motivation.

Further, the Examiner does not provide the proper motivation for combining the specific teachings of the references together, either. The Examiner appears to rely on knowledge generally known, but the MPEP specifically states that merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). "To reach a proper determination under 35 U.S.C. 103, the Examiner

must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the Examiner must then make a determination whether the claimed invention '*as a whole*' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole," not as a piecemeal combination of elements from various references.

The Examiner has not provided the required rationale. Instead, the Examiner merely relies on the general statement that one skilled in the art would have no difficulty doing so. That is not sufficient motivation. The issue is not whether one skilled in the art could do so, but whether there is motivation for one skilled in the art to actually do so. The Examiner has not provided such motivation.

Accordingly, the rejections for obviousness are not supported by the Office Action, and thus the rejections are improper, and should be withdrawn. In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33782.

Respectfully submitted,

PEARNE & GORDON, LLP

By: _____
Robert F. Bodi – Reg. No. 48,540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Dated: September 6, 2005